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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/444,739	11/22/1999	MICHAEL G. MIKURAK	AND1P355	9035
29838	7590	08/23/2005	EXAMINER	
OPPENHEIMER WOLFF & DONNELLY, LLP (ACCENTURE) PLAZA VII, SUITE 3300 45 SOUTH SEVENTH STREET MINNEAPOLIS, MN 55402-1609				MEINECKE DIAZ, SUSANNA M
ART UNIT		PAPER NUMBER		
		3623		

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/444,739	MIKURAK, MICHAEL G.
	<b>Examiner</b>	<b>Art Unit</b>
	Susanna M. Diaz	3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 27 April 2005.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 20-25,27-45,47-50,52-71,73-84 and 86-117 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 20-25,27-45,47-50,52-71,73-84 and 86-117 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a))

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This non-final Office action is responsive to Applicant's amendment filed April 27, 2005.

Claims 20-25, 27-45, 47-50, 52-71, 73-84, and 86-117 are pending.

#### ***Claim Objections***

2. Claim 20 is objected to because of the following informalities:

Claim 20, line 3, insert -- by -- after "use

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 20-25, 27-45, 47-50, 52-71, 73-84, and 86-117 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 20-25, 27-45, 47-50, 52-71, 73-84, and 86-117 recite various limitations that are not expressly or implicitly disclosed as part of the same embodiment in the

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specification. It should also be noted that pending claims 20-25, 27-45, 47-50, 52-71, 73-84, and 86-117 were submitted as new claims on April 29, 2003 (i.e., after the instant application was filed) and are therefore not part of the originally filed disclosure, thereby raising both issues of adequate written disclosure and new matter.

For example, claims 20-25, 27, and 28 recite many details of the disclosed embodiment "for combined industry supply management between one or multiple manufacturers 202 and one or more service providers 204 and/or vendors and/or resellers, etc." (Page 29, lines 14-16 of the specification) This embodiment emphasizes collaboration at the business-to-business level. While "components that manage end-to-end supply chain information such as demand planning, order fulfillment, scheduling, inventory, etc." are part of this embodiment, these components are only briefly described and done so mainly in the context of direct usage by a manufacturer, service provider, reseller, or vendor (as opposed to direct usage by the individual end customer). Furthermore, the principle commodity of interest in this embodiment is network capacity. (Utility commodities, such as electric, gas, and water, are listed as alternate variations of the network capacity embodiment on page 40 of the specification.) However, claims 29-34 (which depend from claims 20 and 24) recite details directed toward targeting offers to a user, wherein the user is one of the business entities. The targeted marketing and customized interface embodiments are described as part of the Relationship Management embodiments (pages 389-434). The specification explains the Relationship Management embodiments without any direct tie-in to the business-to-business supply chain collaboration embodiment; therefore,

Applicant's disclosure fails to clearly set forth if, or how, Applicant intends to integrate the supply chain collaboration embodiment with the Relationship Management embodiments to create one cohesive embodiment that is fully supported by Applicant's originally filed disclosure. Furthermore, the Relationship Management embodiments typically take into account an individual user profile when making marketing decisions (e.g., to customize an interface or targeted information). There is no express mention of profiling the manufacturer, service provider, reseller, or vendor. Instead, the user in the Relationship Management embodiments appears to be an individual end customer that is separate and distinct from an enterprise. "Attributes from the user's profile will be the input to the personalization process and the driving data for the different personalization techniques." (Page 408, lines 18-20 of the specification) If the enterprise were either the manufacturer, service provider, reseller, or vendor, it does not make sense that either enterprise would profile itself, thereby supporting Examiner's assertion that the disclosure does not provide adequate written disclosure regarding the correlation between the recited user and a manufacturer, service provider, reseller, or vendor in the context recited in claims 29-34. User profile details are also recited in dependent claims 57 and 63-65, thereby presenting the same issues.

Similarly, claim 42 recites the step of "using at least one of incentives and disincentives to influence the user indicia that is entered." The specification does not expressly clarify which types of users (e.g., the manufacturer, service provider, reseller, or vendor or a distinct individual end customer) are offered these incentives and disincentives to influence the user indicia that is entered.

Dependent claims 44 and 45 recite various services made available to a user, including news reader capabilities. Again, the news reader capabilities are described as content targeted to a user based on his/her profile and the specification does not expressly clarify which types of users (e.g., the manufacturer, service provider, reseller, or vendor or a distinct individual end customer) are the recipients of such targeted content. Even if a manufacturer, service provider, reseller, or vendor were to become a recipient of targeted content, this embodiment is not expressly disclosed as usable with the supply chain collaboration environment. Due to a lack of nexus among these recited features, the Examiner again submits that the specification fails to provide adequate written disclosure of the claimed invention as a whole.

Claims 66-71, 73-84, and 86-102 recite many of the same combinations of limitations addressed in the rejections of claims 20-25, 27-45, 47-50, and 52-65 above; therefore, the same rejections apply.

Claims 103-117 recite many of the same combinations of limitations addressed in the rejections of claims 20-25, 27-45, 47-50, and 52-65 above; therefore, the same rejections apply.

Appropriate correction and/or clarification is required.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 20-25, 27-45, 47-50, 52-71, 73-84, and 86-117 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Variations of the word "providing" are recited throughout claims 20-25, 27-45, 47-50, 52-71, 73-84, and 86-117. Use of this term (and its variations) renders the claims vague and indefinite because the scope of this term is unclear. By "providing" a given connection or tool, is that connection or tool actively used or is the capability of using it merely made available for potential use?

Claims 66-71, 73-84, and 86-117 recite a computer program product embodied on a computer readable medium; however, the program is not expressly recited as being executable, thereby rendering these claims as being in improper computer program product format (as set forth in MPEP 2106).

Claim 73 is dependent from cancelled claim 72, which is improper. For examination purposes, claim 73 will be interpreted as dependent from claim 66 instead.

Claims 103-117 recite a system comprising various logic circuits; however, it is not clear what a logic circuit is. Is it software *per se* or a hardware element that executes software? System claims require physical/hardware elements.

System claims 113 and 114 are dependent from computer program product claims 100 and 101, respectively, which is improper since there is no antecedent basis for the system recited in preambles of claims 113 and 114. For examination purposes, it will be assumed that claims 113 and 114 are dependent from claim 103.

As per the rejections under 35 U.S.C. 112, 1<sup>st</sup> paragraph set forth above, claims 20-25, 27-45, 47-50, 52-71, 73-84, and 86-117 recite various limitations that are not expressly or implicitly disclosed as part of the same embodiment in the specification. The claims as recited fail to provide nexus among the limitations that were indicated as corresponding to separate and distinct embodiments. This lack of nexus places the intended scope of the claims in question because it is not clear if Applicant is attempting to recite various separately patentable and distinct inventions in the claims or if Applicant's invention is the integration of all recited features in one conglomerated system.

Appropriate correction and/or clarification is required.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 20-25, 27-45, 47-50, 52-71, 73-84, and 86-117 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

While claims 20-25, 27-45, 47-50, and 52-65 recite a useful, concrete, and tangible result, the integration of hardware with the claimed invention is nominal since the recited network is only used to facilitate communications, which may be as simple as sending data back and forth among various human users. It is not clear that any hardware/processor elements substantially effect any core steps, such as an analysis or

calculation step; therefore, claims 20-25, 27-45, 47-50, 52-65 are deemed to be non-statutory for failure to be apply, involve, use, or advance the technological arts.

Claims 66-71, 73-84, and 86-102 recite a computer program product embodied on a computer readable medium; however, the program is not expressly recited as being executable (as required by MPEP 2106). Therefore, claims 66-71, 73-84, and 86-102 are currently interpreted as software *per se*, which is non-statutory.

Claims 103-117 recite a system comprising various logic circuits; however, it is not clear what a logic circuit is. Is it software *per se* or a hardware element that executes software? System claims require physical/hardware elements. Until expressly clarified in the claim language that logic circuits include some sort of physical/hardware elements, claims 103-117 will be interpreted as software *per se*, which is non-statutory.

Appropriate correction is required.

*In light of the numerous rejections under 35 U.S.C. 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs set forth above, the Examiner will not address the claims on their merits at this point, especially since the metes and bounds of many of the claims would require substantial guesswork without clarifying answers to the numerous questions and issues presented in these § 112 rejections. However, the most recent art rejection is hereby withdrawn.*

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Susanna Diaz*  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623

August 8, 2005